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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/532,400	03/22/00	HUME J	042914.00700

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BRACEWELL & PATTERSON L L P
SOUTH TOWER PENNZOIL PLACE
711 LOUISIANA STREET
SUITE 2900
HOUSTON TX 77002-2781

EXAMINER	
ROCHE, L	
ART UNIT	PAPER NUMBER
1771	8

DATE MAILED: 09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/532,400	HUME, JAMES M	
	Examiner	Art Unit	
	Leanna Roche	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *July 28, 2001* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Applicant's amendments filed July 28, 2001 have been entered and carefully considered. Applicant's election of Group I, claims 1-17, has been affirmed, and claims 18-21 have been removed from further consideration. Applicant's amendments to claims 7, 12-14 and 16-17 are sufficient to overcome the previous rejection for lack of antecedent basis under 35 U.S.C. 112, second paragraph.

Double Patenting

2. The examiner acknowledges that Applicant has agreed to file a terminal disclaimer to obviate a provisional double patenting rejection over a pending second application upon allowance of the claims. However, a terminal disclaimer cannot overcome a double patenting rejection. Note that a terminal disclaimer can only be used to overcome an obviousness-type double patenting rejection, see MPEP 804. In view of the amendments to overcome U.S.C. 112, 2nd paragraph rejections, the double patenting rejection has been revised for clarification.

3. Claims 1, 2, 5, 8-12, and 14-17 of this application conflict with claims 1-12 of Application No. 09/328328. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 6 is drawn to a liner where the surfacer layer is composed of a foam. Claim 6 depends from claim 2 which requires that the surfacer layer be composed of an epoxy. The specification does not support a claim wherein the surfacer layer is both an epoxy and a foam.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 5, 7-12, and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hume et al. (USPN 5618616) substantially as set forth in Paper No. 6 paragraph 16.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1, 2, 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hume et al. (USPN 5618616) substantially as set forth in Paper No. 6 paragraph 18.

10. Claims 3, 4, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hume et al. (USPN 5618616) in view of Grinshpun et al. (USPN 5955013) substantially as set forth in Paper No. 6 paragraph 19.

Response to Arguments

11. Applicant's arguments filed July 28, 2001 have been fully considered but they are not persuasive. Applicant argues that Applicant's invention does not require a primer layer as set forth and required by Hume. However, as explained in Paper No. 6, the language of Applicant's claim 1, "a bi-layer liner **comprising**," does not exclude the

presence of an additional layer and would therefore read on embodiments in which additional layers are present.

12. Applicant argues that Applicant's invention does not contain an intermediate foam layer as set forth and required in Hume. This assertion is incorrect because Applicant's claim 10 is directed to a multi-layer liner comprised of a first barrier layer, a surfacer layer disposed on said first barrier layer , and a second barrier layer disposed on said surfacer layer. Claim 11 states that the surfacer layer is a foam. Therefore, an intermediate foam layer disposed between first and second barrier layers, as disclosed by Hume, reads directly on these claims.

13. With regard to the rejection of claims 1, 2, 5, and 7-9 under 35 U.S.C. 103(a), Applicant argues that Applicant's invention does not utilize a primer nor an intermediate foam layer as set forth and required by Hume. Again, as previously stated in Paper No. 6, the language of Applicant's claim 1, "a bi-layer liner **comprising**," does not exclude the presence of an additional layer and would therefore read on embodiments in which additional layers are present. Therefore, with regard to the primer of Hume, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have eliminated the primer layer of Hume, motivated by the desire to reduce the overall thickness and cost of the liner. With regard to the intermediate foam layer, it would have been obvious to the skilled artisan to have eliminated one of the barrier layers, motivated by the desire to obtain a layer which exhibits barrier properties on only one surface of the liner. Such an embodiment would be desired where barrier

properties are not needed on one of the surfaces of the liner, i.e., when the liner is bonded to the wall of a container.

14. In response to applicant's argument that Grinshpun does not speak of a liner for rehabilitating or repairing waste water system components, does not teach that polyurea foams and epoxies can be utilized in the process for rehabilitating or repairing waste water systems, and does not teach with regards to lining waste water systems that requires specific knowledge regarding the nature and the use of waste water systems, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Hume is relied upon to teach a liner for rehabilitating or repairing waste water system components. Grinshpun is relied upon to show that combining a polyurea foam layer with an epoxy resin layer results in structures with improved insulating properties. Improving the insulating properties of a liner for rehabilitating or repairing waste water system components would have been obvious to one having ordinary skill in the art.

For these reasons, Applicant's arguments are not found persuasive of patentability.

Conclusion

15. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leanna Roche whose telephone number is 703-308-6549. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm (with alternate Mondays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 703-308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

lmr
September 25, 2001

BLAINE COPENHEAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700